

### Remarks

This Response is filed in reply to the Office Action dated **June 18, 2007**. Claims 1-12 and 20-27 are pending in this application. The Office Action rejected claims 1, 2, 4, 5, 7-11, 20-22 and 24-27 under 35 USC § 102 over Ching (US 6481262); and rejected claims 6, 12 and 23 under 35 USC § 103 over Ching.

The rejections are traversed. Reconsideration in view of the following remarks is requested.

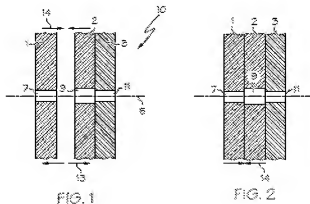
### Allowable Subject Matter

Applicants acknowledge the Office Action's indication of allowable subject matter in claim 3, however, for the reasons set forth below, Applicants assert that all of the claims are patentable over Ching under 35 USC §§ 102 & 103.

### Claim Rejections – 35 USC § 102

The Office Action rejected claims 1, 2, 4, 5, 7-11, 20-22 and 24-27 under 35 USC § 102 over Ching. These rejections are traversed.

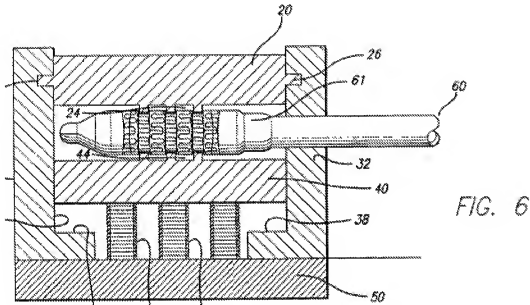
Claim 1 recites a “first cylindrical member defining a longitudinal axis,” and requires a first plate to be “moveable...along the longitudinal axis.” Claim 20 similarly requires a first plate to be “moveable relative to the second plate along the length of the catheter.” Claim 21 requires a first plate and a second plate to be “moveable relative to one another to adjust a distance between the first nest and the second nest as measured along the length of the catheter.”



Applicants' Figures 1 and 2, provided above, show a plate 1 moving along the

length/longitudinal axis 5 of a cylindrical member that would be placed in the claimed device.

Ching teaches a stent crimping device having a horizontally sliding plate 20 and a vertically sliding plate 40. See column 4, lines 21-26 and Figure 6, provided below. Each plate includes ribs 24, 44 that are used to crimp portions of a stent. See e.g. Figure 6. Ching also shows a catheter 60, and the structural relationship between the catheter and the moveable plates 20, 40. See Figure 6 below.



A person of ordinary skill in the art would recognize that the horizontally sliding plate 20 moves laterally with respect to the catheter 60, in a direction perpendicular to the catheter axis. A person of ordinary skill in the art would also recognize that the vertically sliding plate 40 moves radially with respect to the catheter 60, in a direction perpendicular to the catheter axis.

Ching does not teach a plate that can be characterized as moving along the longitudinal axis of the catheter 60, as would be required to meet the limitations of claim 1, or characterized as moving along the length of the catheter 60, as would be required to meet the limitations of claims 20 or 21. This assertion was made in the Amendment filed 3/20/07.

In response, the Office Action asserts that for the purposes of the rejection, "the longitudinal direction of cylindrical members and the plates have been treated as being different, since the claims are directed solely to the positioning assembly and not the combination of the positioning assembly and first and second cylindrical members." See Office Action at page 5, and

a similar assertion at pages 6-7.

Thus, as best understood, it appears that the rejection defines a “longitudinal direction of the plates” and a separate “longitudinal direction of the cylindrical member,” and asserts that because a plate is moveable in the “longitudinal direction of the plates,” the claim limitations directed to the “longitudinal direction of the cylindrical member” are met. This assertion is traversed.

Claims are interpreted according to their plain meaning, and the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Claim 1 defines the claimed “longitudinal axis” as that of the “first cylindrical member.” Claim 1 further recites movement “along the longitudinal axis.” Thus, the recited movement is clearly defined as being along the previously defined longitudinal axis of the cylindrical member. The claim does not include the cylindrical member, but it does define the required longitudinal axis by reference to how the cylindrical member would be positioned in the device. The plain meaning of the language of claim 1 precludes the reasoning asserted in the rejection. A “longitudinal direction of the plates” as mentioned in the rejection is not relevant to the claim. Claim 1 simply does not read on the Ching device.

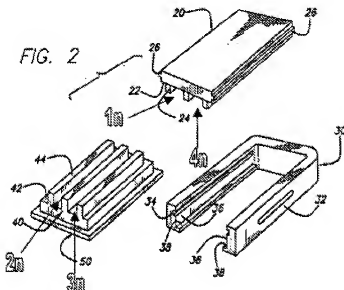
Claim 20 similarly defines a “catheter” and requires the first plate to be moveable “along the length of the catheter.” Claim 21 similarly defines a “catheter” and requires the first plate to be moveable “to adjust a distance...as measured along the length of the catheter.” The language of claims 20 and 21 each preclude the reasoning asserted in the rejection. A “longitudinal direction of the plates” as mentioned in the rejection is not relevant to claims 20 or 21, which simply do not read on the Ching device.

The pending claims define a longitudinal axis/catheter, and then specifically define movement of a plate with respect to how the longitudinal axis /catheter is positioned in the device. Although the physical presence of a cylindrical member/catheter is not required, appropriate movement of the plates with respect to such a cylindrical member/catheter is required to meet the limitations of the pending claims.

Movement of the Ching plates, being perpendicular to the catheter axis, is clearly different from the movement recited in the pending claims. Therefore, Applicants assert that

Ching does not disclose or suggest all of the limitations of independent claims 1, 20 and 21, and that these claims are patentable over Ching under 35 USC § 102.

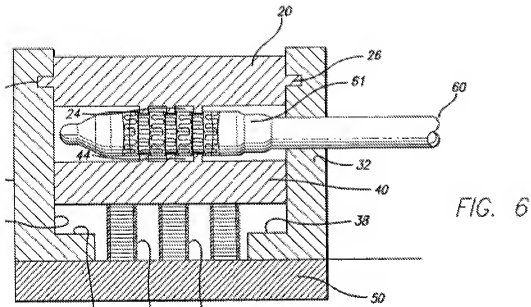
Further with respect to the claimed “nests,” the Office Action asserts Ching teaches nests as shown in the Figure reproduced below. See items 1n, 2n, 3n, 4n and Office Action at page 6.



Claim 1 recites, “the first plate having a first nest to accommodate at least a portion of the first cylindrical member, the second plate having a second nest to accommodate at least a portion of the second cylindrical member.” Claims 20 and 21 each recite, “the first plate having a first nest to accommodate at least a portion of the catheter, the second plate having a second nest to accommodate at least a portion of the marker.”

A person of ordinary skill in the art would recognize that the “nests” as defined in the rejection cannot accommodate a portion of the Ching catheter, as would be required to meet the limitations of claims 1, 20 or 21.

In the Ching device, the lowermost surfaces of ribs 24 and the uppermost surfaces of ribs 44 contact the Ching stent and function to crimp the stent onto the catheter. See e.g. Figure 6, provided below.



Although portions of the Ching stent can extend into the Ching “nests” as defined in the Office Action, a person of ordinary skill in the art would recognize that no portion of the catheter would ever become oriented with a Ching “nest.” Thus, Ching does not disclose or suggest a “nest” to accommodate at least a portion of the first cylindrical member, as recited in claim 1, or to accommodate at least a portion of the catheter, as recited in claims 20 and 21.

Therefore, Applicants assert that Ching does not disclose or suggest all of the limitations of independent claims 1, 20 and 21, and that these claims are patentable over Ching under 35 USC § 102. Each rejected dependent claim is patentable over Ching for at least the reasons discussed with respect to the independent claim from which it depends. Accordingly, Applicants request withdrawal of the rejections under 35 USC § 102 over Ching.

#### **Claim Rejections – 35 USC § 103**

The Office Action rejected claims 6, 12 and 23 under 35 USC § 103 over Ching. These rejections are traversed.

The Office Action admits that Ching does not disclose the limitations recited in the rejected claims, but then asserts “it would have been an obvious matter of design choice to modify Ching to obtain the invention as specified in claims 6, 12 and 23.” See Office Action at pages 6-7.

The rejection does not provide any prior art references, or assert any prior art

teaching, that would motivate a person of ordinary skill in the art to modify Ching. Thus, the rejection ignores a lack of direction from the prior art.

Each element of an invention is subject to a “design choice.” For a given element of an invention, out of a broad realm of possible choices, a claim limitation defines a specific choice that has been made. Asserting that a specific claim limitation is a “design choice” is analogous to asserting that the claim limitation at issue is merely possible. In order for a claim to be rejected as obvious, there must be a showing that a person of ordinary skill in the art would have been led to the claimed configuration. Absent a prior art motivation that would guide an inventor to the claimed configuration, there is nothing that makes the claimed configuration obvious.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

Due to the lack of prior art, the rejection fails to present any of the three basic criteria required to establish a *prima facie* case of obviousness. Applicants request withdrawal of the rejections under 35 USC § 103.

**Conclusion**

Based on at least the foregoing remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-12 and 20-27 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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